

REMARKS

Applicant respectfully requests reconsideration of this application, and reconsideration of the Office Action dated October 1, 2003 (Paper No. 23). Upon entry of this Amendment, claims 12-41 will remain pending in this application. The amendment to claims 29 correct an obvious typographical error pointed out by the Examiner in the last Office Action and is fully supported by the specification and original claims. No new matter is incorporated by this Amendment.

Applicant again gratefully acknowledges that Examiner's indication that claims 17, 19-21, 24, 32 and 38 contain allowable subject matter. While claims 17, 19-21, 24, 32, and 38 were again objected to, the Examiner has again indicated that these claims would be allowable if rewritten in independent form and including all of the elements of the base claim and any intervening claims. As an initial matter, Applicant again respectfully notes that claim 32 is currently in independent form. Accordingly, it is believed that claim 32 is allowable in its present amended state.

With respect to claims 17, 19-21, 24, and 38, Applicant respectfully submits that, as discussed below, the claims from which claims 17, 19-21, 24, and 38 depend are also free of the prior art and thus also allowable in their current state.

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Claim 29 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In response, Applicant has corrected the obvious typographical error in claim 29 so that it recites "wherein said fluid filter is positioned downstream of said magnet and said pair of metal plates." Hence, the rejection is overcome and its withdrawal is respectfully requested. In addition, Applicants respectfully submit that this change to claim 29 does not present any new issues which would keep this Amendment from being entered (see paragraph 17 of final Office Action).

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The rejection of claims 12-16, 18, 22, 23, 25-30, 33, 34, and 36, 37, and 39-41 under 35 U.S.C. §103(a) as obvious based on Morrick (U.S. Pat. No. 5,389,252) was maintained. Applicant again respectfully traverses.

As an initial matter, Applicant notes the statement in paragraph 31 in the Office Action. Paragraph 31 indicated that Applicant failed to specifically point out how the language of the claims distinguish over Morrick. In response, Applicant directs the Examiner's attention to the last Amendment wherein it was explained that the present device includes a magnet and a pair of metal plates. Applicant's response goes on to state, "Nowhere in the specification [of Morrick] is it even suggested that the device of Morrick includes two particle-collecting disks." Applicants response goes on to explain why those of ordinary skill in the art would not interpret Morrick as teaching or suggesting employing two particle collecting plates. Hence, Applicant submits that they did specifically point out how the language of the claims patentably distinguish over Morrick.

Contrary to the assertion in the Office Action, Applicant again submits that Morrick in no way teaches or fairly suggests employing two particle collecting plates as is recited in the claims. Moreover, Applicant incorporates all of the arguments asserted in the last Amendment filed July 23, 2003 to rebut the assertions made in the Office Action. In addition, Applicant also submits herewith a Declaration signed by Dr. Philip J. Grundy that explains that those of ordinary skill in the art would not interpret Morrick as teaching or even suggesting employing two particle collecting plates.

Applicant also makes the following comments in response to the assertions made in the office action. In paragraph 28, the office action asserted the device of Morrick would not operate properly if the cover plate were metal as the magnet would magnetize the cover plate causing the metal plate to attract ferromagnetic material and become clog. In response, Applicant submits there is nothing in Morrick which teaches using more than one particle collecting plate. Moreover, there is nothing in the teachings of Morrick which indicate using any type of filter

other than the conventional filters which employs a metal cover plate. Second, as explained on pages 1 and 2 of the present specification, clogging is one of the problems associated with the magnetic filter devices of the prior art. This issue is one of the problems that led to the present invention which employs collecting plates oriented on either side of a magnet so that the pole pieces and recesses of the plates are axially aligned with respect to both plates. This feature creates magnetic flux distributions that divert ferromagnetic material in the fluid towards the regions defined by opposite pairs of pole pieces and thus reduces clogging. This feature of the claimed invention is neither taught nor fairly suggested by Morrick.

In paragraph 29, the Office Action asserted that “the two plates having opposite polarity and/or not identical” feature is not claimed. However, Applicant directs the Examiner’s attention to, for example, independent claim 12 which states, “said magnet having faces of opposite magnetic polarity, each of said plates being disposed in abutment with a respective one of said magnet faces.”

In paragraph 30, the Office Action asserted, “It makes better sense to have another magnet-disk combination on top of the one already shown in the figures.” However, as previously asserted and as discussed in the attached declaration, there is nothing in the teachings of Morrick which suggests using two particle collecting plates. It is only thorough hindsight, improperly using the teaching the Applicant’s specification, that the Office Action comes to this conclusion. Hence, the rejection is improper.

In view of the declaration and above remarks, Applicant submit that this rejection is overcome. Hence, reconsideration and withdrawal of the rejection is respectfully requested.

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Applicant respectfully submits that this Amendment and the above remarks obviate all of the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees are due in connection with the filing of this Request for Reconsideration, such

as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to our Deposit Account No. 02-4300; Order No. 033988.003.

Respectfully submitted,

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